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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER				
KINGAN, TIMOTHY G				
ART UNIT		PAPER NUMBER		
1797				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/596,438

Applicant(s)

SCHUETZ ET AL.

Examiner

TIMOTHY G. KINGAN

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-27 is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 11, 12, 16 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/003)  
Paper No(s)/Mail Date 06/14/2006 and 09/29/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 24-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are to a method of laser microdissection and incorporate the language "from biological material located in the container by means of a method according to claim 18 in the container"; claim 18 reads on a method of assembling the device and it appears that the word "assembled" should be inserted in front of "by means of a method according to claim 18".

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-8, 10-12 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by K. Landsberger, U.S. Patent 3,749,369 (herein after Landsberger).

5. Landsberger teaches a magnetic stirrer (holding device) comprising a support structure **14** on which a container is supported, the support structure including a magnetic bar **18** (holding portion) to affect rotation of the mixing and measuring device **12** (col 2, lines 26-32; Figs. 1-3) (receiving portion in a container, said portion coupled in contactless manner to the holding portion). Landsberger further teaches the mixing and measuring device **12** comprises a chamber **27** defined by a cavity **30** (col 2, lines 40-42) for holding additives (col 4, lines 10-12) (cap-like receiving/collecting element, held by receiving portion). The mixing measuring element **12** (receiving portion), held in the container, is fully capable of holding a plurality of cavities **30** (receiving elements) and is preferably made of an inert material such as tetrafluoroethylene polymer (col 2, lines 35-37) (polytetrafluoroethylene). Further, the magnetic bar **18** (holding portion) and the mixing device **12** (receiving portion) are coupled in a contactless manner by magnetism, and the container **16** is open at the top (Fig. 1) and may be transparent (allows illumination of receiving element). With respect to claims 2, 3, 11-12 and 16 , Examiner notes that intended use language in apparatus claims is not accorded patentable weight where the statement of intended use does not distinguish over the prior art apparatus (MPEP 2111.02).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 9, 13-14 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsberger.

For Claim 9, Landsberger does not teach the material comprising the magnetic bar 18 (holding portion). It would have been obvious to one of ordinary skill in the art at the time of invention to use a material such as Teflon (tetrafluoroethylene polymer) in order to provide a durable and low friction material capable of withstanding prolonged movement.

For Claims 13 and 14, Landsberger does not teach the container taking the form of a Petri dish or a container comprising a base and a cover. It would have been obvious to one of ordinary skill in the art to use a container comprising a Petri dish (with a base and a cover), as one of a limited number of alternate shapes, in order to provide the convenience of such inexpensive and disposable containers, without loss or compromise of function. Further, one of ordinary skill in the art would have found desirable to use a dish with a cover in order to allow addition or removal of material

before and after operation of the device while maintaining a clean working environment for the container.

For Claims 17-22, Landsberger does not teach the device designed for computer-assisted position. The structure as disclosed in Landsberger is fully capable of use in laser microdissection and computer-assisted adjustment of the magnetic bar (holding portion of the holding device) through control of the motor **20** and it would have been obvious to one of ordinary skill in the art to use such control in order to provide the automation of control provide by a computer and controlling software. Further, Landsberger does not specifically teach the steps of a method to arrange a receiving and holding portion with respect to each other, the receiving portion being in the container. Examiner notes that such steps are inherent to the structure, in that the device of Landsberger comprises the structural components of the instant claim, fully assembled. It would have been obvious to one of ordinary skill in the art to assemble such device for operation by a method comprising the step of placing the magnetic bar with cavity (receiving portion with receiving element) into the container at the base (which comprises a cover) and in contactless coupling with the magnetic bar **18** (holding portion in the vicinity of the receiving portion) which is outside the base (cover) of the container.

For Claim 23, Landsberger does not teach sterilizing the magnetic bar with cavity (receiving portion) prior to assembly of the device. It would have been obvious to one of ordinary skill in the art to sterilize such element in order to provide for prevention of

microbial contamination of reagents or biological materials in the container that might adversely alter the reactivity or composition of such materials.

***Allowable Subject Matter***

9. Claim 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. In the instant case, no prior art of record was found that teaches or fairly suggests a container with first and second membranes that are laser light transmitting and absorbing, respectively, and for which one of ordinary skill in the art would find motivation to combine with the device of Landsberger.

Claims 24-27 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action. The claims recite the elements of a method of laser microdissection with use of a device comprising a container with holding and receiving portions that are in contactless coupling. No prior art of record teaches or fairly suggests laser microdissection with such device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMOTHY G. KINGAN whose telephone number is

(571)270-3720. The examiner can normally be reached on Monday-Friday, 8:30 A.M. to 5:00 P.M., E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TGK

/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797